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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,109	03/10/2004	Hermann Meyer	10901/63	5925
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KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			PAINTER, BRANON C	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[uspto@kenyon.com](mailto:uspto@kenyon.com)

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/798,109	MEYER, HERMANN
	Examiner Branon C. Painter	Art Unit 3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 March 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/10/04 and 05/19/04</u> .                                   | 6) <input type="checkbox"/> Other: _____.                         |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species B (Fig. 4A) in the reply filed on 09/13/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Information Disclosure Statement***

2. The information disclosure statements (IDS) submitted on 03/10/04 and 05/19/04 are being considered by the examiner.

### ***Claim Objections***

3. Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 6 and 7 both claim that the second axial section is farther from the center axis than the first axial section.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4, 6-14, 16-17, 19, and 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 4 is vague and indefinite because of the phrase "one second axial section configured so that the inner surface of the tension ring does not rest against the outer wall of the tubular element." This is in direct contradiction to independent claim 1, which includes the phrase "adapted to rest by only a first axial partial section of the inner surface against the outer wall of the tubular element." Both axial sections are part of the inner surface of the tension ring. For the purpose of this examination, the examiner presumes that only the first axial section of the tensioning ring should contact the outer wall of the tubular element.
7. Claims 1-2, 4, 6-14, 16-17, 19, and 22 recite the limitation "the tubular element." There is insufficient antecedent basis for this limitation in the claim because, in claim 1, a tubular element is never positively claimed. Merely stating that the arrangement is "adapted to" connect a tubular element does not limit the claim to a particular structure, and fails to properly positively claim the tubular element. For the purpose of this examination, the examiner presumes that "the tubular element" refers to "hollow shaft" in Fig. 1.
8. Claims 1, 3, and 23 recite the limitation "the body." There is insufficient antecedent basis for this limitation in the claim because, in claim 1, a body is never positively claimed. For the purpose of this examination, the examiner presumes that "the body" refers to "drive shaft" in Fig. 1.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

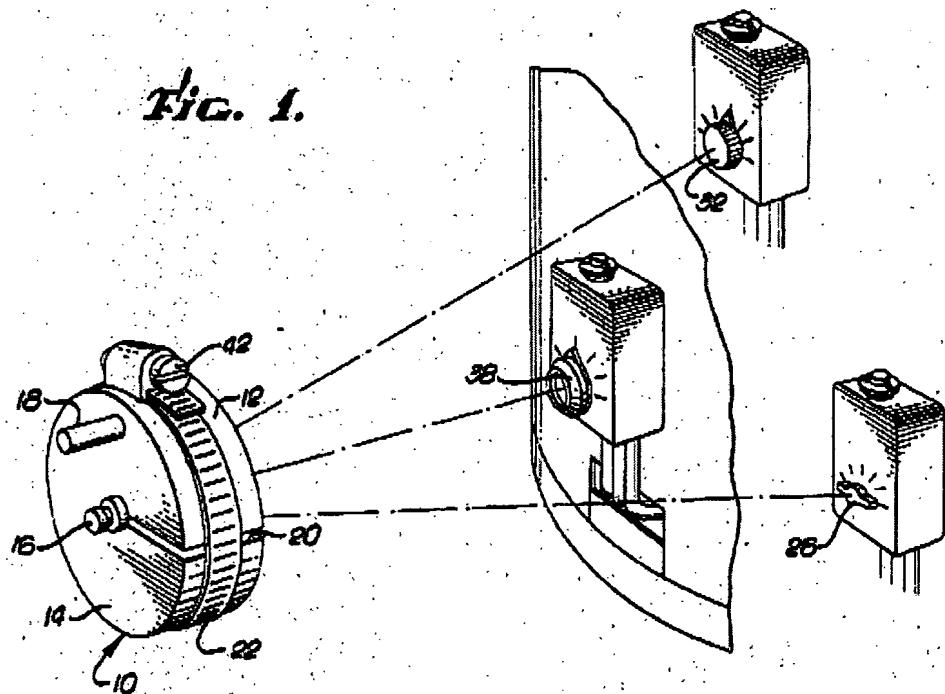
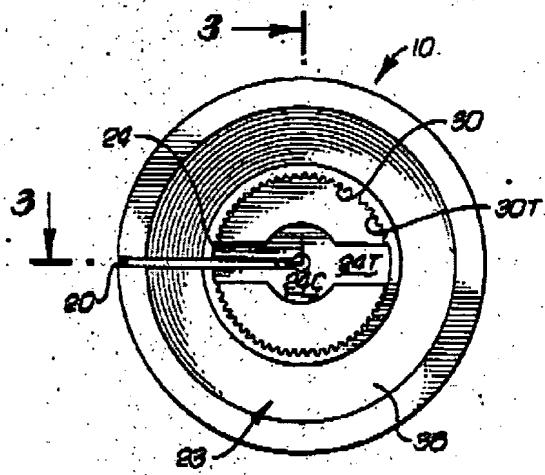
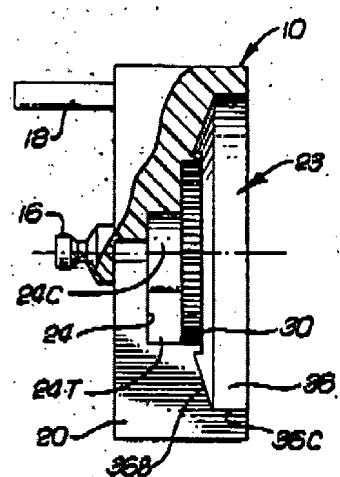
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 4-7, 16-21, and 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Stansbury, Jr. et al. (U.S. Patent No. 4,692,051).

11. Regarding claim 1, Stansbury, Jr. et al. discloses an adapter having all of the applicant's claimed structure, including:

An arrangement adapted to connect a tubular element ("knob" 32, Fig. 1) to a body extending into the tubular element (a shaft inherently must extend from the box to the knobs in Fig. 1, as the device is analog, not digital), comprising: a tension ring ("cylindrical body" 12, Fig. 1) adapted to embrace, by an inner surface ("inner portion" 23, Fig. 2), an outer wall of the tubular element, the tension ring adapted to extend axially along the tubular element and adapted to apply a clamp force to the tubular element (via "clamp" 22, Fig. 1) so that the tubular element acts via an inner wall of the tubular element on the body extending into the tubular element to clamp the tubular element; wherein the tension ring is adapted to rest by only a first axial partial section of the inner surface ("serrated ring" 30, Fig. 2) against the outer wall of the tubular element ("knob" 32, Fig. 1) and is adapted to exert a clamp action on the outer wall of the tubular element.

*FIG. 1.**FIG. 2.**FIG. 3.*

Reproduced from U.S. Patent No. 4,692,051

12. The examiner notes that claim scope is not limited by claim language such as "adapted to," which suggests or makes optional but does not require steps to be

performed, or by claim language that does not limit a claim to a particular structure.

See MPEP 2111.04.

13. The examiner further notes that if the claim language were altered to remove the “adapted to” language, Stansbury, Jr. et al. would still read on the claim as shown by the parallels drawn above between Stansbury, Jr. et al. and applicant.
14. Regarding claim 4, Stansbury, Jr. et al. discloses a second axial section (“frosto-conical portion” 36B, Fig. 3).
15. Regarding claim 5, Stansbury, Jr. et al. discloses a second axial section that is axially thicker than the first axial section (Fig. 3).
16. Regarding claims 6 and 7, Stansbury, Jr. et al. discloses a second axial section farther from the center axis than the first axial section (second axial section “frosto-conical portion” 36B, Fig. 3).
17. Regarding claim 16, Stansbury, Jr. et al. discloses a tension ring with a plurality of clamp points along the inner circumference of the ring to rest against the tubular element (“serrated ring” 30, Fig. 2).
18. Regarding claim 17, Stansbury, Jr. et al. discloses an inner surface with three clamp points (“serrated ring” 30, Fig. 2).
19. Regarding claim 18, Stansbury, Jr. et al. discloses a tension ring with integrally molded protrusions (“serrated ring” 30, Fig. 2). The examiner notes that claim 18 is considered to be a product-by-process claim due to the phrase “molded.” The patentability of the product does not depend on its method of production.

Determination of patentability is based on the product itself. See MPEP 2113. If

the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

20. Regarding claim 19, Stansbury, Jr. et al. discloses equidistant clamp points on the tension ring (“serrated ring” 30, Fig. 2).
21. Regarding claim 20, Stansbury, Jr. et al. discloses a weak point between each two adjacent clamp points (valleys in “serration ring” 30, Fig. 2).
22. Regarding claim 21, Stansbury, Jr. et al. discloses a tension ring capable of connecting a hollow shaft to a drive shaft (“cylindrical body” 12, Fig. 1). The examiner makes further note of the fact that “adapted to” language does not limit the scope of the claim, and therefore all that is needed to meet the claim limitations is the capability to perform said action.
23. Regarding claim 26, Stansbury, Jr. et al. discloses a weak spot adapted to act as a joint (valleys in “serration ring” 30, Fig. 2).
24. Regarding claim 27, Stansbury, Jr. et al. discloses an adapter having all of the applicant’s claimed structure as discussed with regard to claim 1.
25. Claims 2-3 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Stansbury, Jr. et al. (U.S. Patent No. 4,692,051).
  
26. Regarding claim 1, Stansbury, Jr. et al. discloses an adapter having all of the applicant’s claimed structure, including:

An arrangement adapted to connect a tubular element ("cylindrical body" 12, Fig. 1) to a body extending into the tubular element ("knob" 32, Fig. 1), comprising: a tension ring ("clamp" 22, Fig. 1) adapted to embrace, by an inner surface, an outer wall of the tubular element, the tension ring adapted to extend axially along the tubular element and adapted to apply a clamp force to the tubular element so that the tubular element acts via an inner wall of the tubular element on the body extending into the tubular element to clamp the tubular element; wherein the tension ring is adapted to rest by only a first axial partial section of the inner surface ("clamp" 22 is capable of resting with only a partial section in contact with "cylindrical body" 12, Fig. 1) against the outer wall of the tubular element ("cylindrical body" 12, Fig. 1) and is adapted to exert a clamp action on the outer wall of the tubular element.

27. Regarding claim 2, Stansbury, Jr. et al. discloses a tubular element with a hollow cylinder ("hollow cylinder" 24C, Fig. 2).
28. Regarding claim 3, Stansbury, Jr. et al. discloses a body including a cylindrical element ("knob" 32, Fig. 1).
29. Regarding claim 22, Stansbury, Jr. et al. discloses a tubular element with a hollow shaft ("cylindrical body" 12 acts as shaft with hollow portion "hollow cylinder" 24C, Fig. 2).
30. Regarding claim 23, Stansbury, Jr. et al. discloses a body including a drive shaft ("knob" 32 acts as a drive shaft as it transmits mechanical power when rotated, Fig. 2).

31. Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Stansbury, Jr. et al. (U.S. Patent No. 4,692,051).
32. Regarding claim 1, Stansbury, Jr. et al. discloses an adapter having all of the applicant's claimed structure as set forth above, with the exceptions that the following are represented by different parts: tubular element ("knob" 26, Fig. 1) and first axial region ("rectangular tab" 24T, Fig. 2).
33. Regarding claim 4, Stansbury, Jr. et al. discloses Stansbury, Jr. et al. discloses a second axial section ("hollow cylinder" 24C, Fig. 2).
34. Regarding claim 8, Stansbury, Jr. et al. discloses a tubular element whose portion that abuts the tension ring first axial section (wings of "knob" 26 abut "rectangular tab" 24T portions, Figs. 1 and 2) is farther from the center axis than the portion that abuts the tension ring second axial section (circular portions of "knob" 26 abut "hollow cylinder" 24C, Figs. 1 and 2).
35. Regarding claim 9, Stansbury, Jr. et al. discloses a tubular element with thickened region with outwardly projecting protuberance (wings of "knob" 26, Fig. 1).
  
36. Claims 10-15 and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Stansbury, Jr. et al. (U.S. Patent No. 4,692,051).
37. Regarding claim 1, Stansbury, Jr. et al. discloses an adapter having all of the applicant's claimed structure as set forth above, with the exceptions that the

following are represented by different parts: tubular element ("knob" 38, Fig. 1) and first axial region ("frosto-conical portion" 36B, Fig. 2).

38. Regarding claim 4, Stansbury, Jr. et al. discloses Stansbury, Jr. et al. discloses a second axial section ("cylindrical portion" 36C, Fig. 2).
39. Regarding claim 10, Stansbury, Jr. et al. discloses a tension ring coupled to an unattached end of a tubular element ("cylindrical body" 12, Fig. 1).
40. Regarding claim 11, Stansbury, Jr. et al. discloses a first axial section facing an end face of the unattached end of the tubular element ("frosto-conical portion" 36B, Fig. 2).
41. Regarding claim 12, Stansbury, Jr. et al. discloses a projection on the end face of the unattached end of the tubular element (raised projecting portion on outer face of "knob" 38, Fig. 1).
42. Regarding claim 13, Stansbury, Jr. et al. discloses a wall with smaller thickness than the tubular element's contiguous axial region (raised projecting portion on outer face of "knob" 38, Fig. 1).
43. Regarding claim 14, Stansbury, Jr. et al. discloses a shoulder transitioning between the unattached end to the contiguous axial region (beveled region between raised projecting portion and base portion of "knob" 38, Fig. 1).
44. Regarding claim 15, Stansbury, Jr. et al. discloses a tension ring positionable in an axial position directly next to the shoulder ("cylindrical body" 12, Fig. 1).

45. Regarding claim 24, Stansbury, Jr. et al. discloses an outwardly protruding projection arranged as a circumferential flange (raised projecting portion on outer face of "knob" 38, Fig. 1).
46. Regarding claim 25, Stansbury, Jr. et al. discloses a tension ring restable against the shoulder ("cylindrical body" 12, Fig. 1).

### ***Conclusion***

47. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Branon C. Painter whose telephone number is (571) 270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner  
Art Unit 3635

Branon Painter  
09/26/2007